

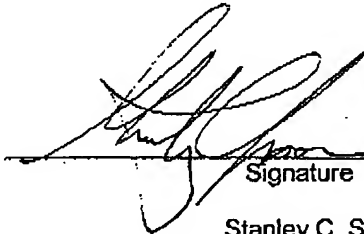
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)
		SCS-550-471
Application Number	Filed	RECEIVED CENTRAL FAX CENTE FEB 01 2007
10/714,483	November 17, 2003	
First Named Inventor	WATT	
Art Unit	Examiner	
2183	B. Johnson	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the <input type="checkbox"/> Applicant/Inventor <input type="checkbox"/> Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> Attorney or agent of record <u>27,393</u> (Reg. No.) <input type="checkbox"/> Attorney or agent acting under 37CFR 1.34. Registration number if acting under 37 C.F.R. § 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*</p> <p><input checked="" type="checkbox"/> *Total of 1 form/s are submitted.</p>		


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February 1, 2007

Date

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**STATEMENT OF ARGUMENTS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

The following listing of clear errors in the Examiner's rejection and his failure to identify essential elements necessary for a *prima facie* basis of rejection is responsive to the Final Rejection mailed November 2, 2006 (Paper No. 20061018).

Error #1. The Examiner fails to identify any portion of the Angelo reference which discloses the step of "setting" in claim 1 or the "storage element" of claim 20

Applicants' independent method claim 1 recites the step of "setting at least one control value, said at least one control value relating to a condition" Similarly, claim 20 recites a storage element for accomplishing the same step. To support a rejection of independent claims 1 and 20 and claims dependent thereon, it is incumbent upon the Examiner to establish where this is taught in the cited references.

The Examiner alleges that this is generally disclosed in the Angelo reference (the numerous citations on page 3 of the Final Rejection are to the Angelo reference). However, on page 3 of the Action, the Examiner suggests that the claimed "setting" step in claim 1 and "storage element" in claim 20 are taught in Angelo at column 7, lines 56-58 and that column 7, line 61 to column 8, line 4 teaches that the control value is related to a condition (also required by claims 1 and 20). From a detailed review of columns 7 and 8, it appears the Examiner is contending that the System Management Interrupt (SMI) is the claimed "control value."

A review of Angelo at columns 7 and 8 indicates that the SMIs which are asserted is a "non-maskable interrupt" having nothing to do with anything "relating to a condition" as in the current claims. There is no reference to a "condition" or suggestion that anything is dependent upon recognition of a "condition." Additionally, there seems to be no stated indication by the Examiner

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as to how or why he believes the SMI is related to or discloses the claimed "condition."

Furthermore, there is no discussion in Angelo that discloses or even suggests that the SMI is "indicative of whether said monitoring function is allowable in said first domain."

As a result of the above, neither of the two features specified by Applicants' "setting" step (claim 1) or "storage element" (claim 20) is disclosed in Angelo, i.e., neither the control value being related to a "condition" nor "being indicative of whether said monitoring function is allowable in said first domain." Because the Examiner fails to identify where either of these features positively recited in independent claims 1 and 20 are present in the Angelo reference, there is no support for the rejection of claims 1-39 under 35 USC §103 and the rejection fails.

Error #2. In view of the Examiner's admission, the Alverson/Angelo combination fails to disclose the claimed "control value"

On page 2 of the Final Rejection, the Examiner admits that Alverson "fails to disclose particular information about monitoring." The above paragraph relating to Error #1 notes that Angelo contains no disclosure of Applicants' "control value" setting step or storage element. Therefore, the combination of Alverson and Angelo fails to contain any disclosure of this claimed element.

In a combination rejection, a claimed element must be disclosed in at least one of the cited references. Here, because the Examiner admits the "control value" is not disclosed in Alverson and provides no identification of where this is taught in Angelo, the combination of Alverson and Angelo does not disclose the claimed "control value" and thus, cannot render obvious the subject matter of independent claims 1 and 20 or claims dependent thereon. Therefore, any further rejection over the combination under 35 USC §103 is respectfully traversed.

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Error #3. There is no allegation that either Alverson or Angelo teaches the claimed "not allowing" step in claim 1 or the similar portion of the "control logic" of claim 20

Applicants' claims 1 and 20 also recite the requirement of "not allowing initiation of said monitoring function in said first domain when said condition is present and its related control value indicates that said monitoring function is not allowable." The Examiner recites verbatim this claim language (at the end of page 3 in the official action) and alleges it is disclosed in Angelo (column 7, line 61 to column 8, line 4). However, a review of the cited portion of Angelo contains no language or suggestion even vaguely related to "not allowing initiation of said monitoring function"

As set out by the Court of Appeals for the Federal Circuit, "[t]he PTO has the burden under section 103 to establish a *prima facie* case of obviousness." (emphasis in original) *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The PTO "can satisfy this burden only by showing some objective teaching in the prior art" *Id.* Here, the Examiner has simply failed to provide any such showing of any teaching in the Alverson/Angelo references of the claimed elements and steps and therefore any further rejection under 35 USC §103 is respectfully traversed.

Error #4. The Examiner appears to ignore the fact that the Angelo "teaches away" from Applicants' independent claims

Applicants' independent claims specify the above-noted step of "not allowing" the monitoring function when the condition is present and the related control value indicates that the monitoring function is not allowable. However, Angelo teaches that its monitoring function, i.e., entry into the System Management Mode (SMM), is always allowed in response to an SMI (the Examiner appears to contend that the SMI is analogous to the claimed "control value"). Because

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Angelo teaches that the monitoring function is always allowed, it would necessarily lead those of ordinary skill in the art away from Applicants' conditional non-allowance and thereby lead away from the combination of elements asserted by the Examiner.

As a result, the non-obviousness of Applicants' claimed subject matter is believed established, especially in view of the Alverson and Angelo teachings and under 35 USC §103.

Error #5. The Examiner provides no support for his "common art" rejection of claims 9, 10, 17 and 37

Claims 9, 10, 17 and 37 stand newly rejected under 35 USC §103 as unpatentable over the Alverson/Angelo combination "in view of common art" on page 11 of the Final Rejection. Because these claims depend from claims 1 and 20, each of the above-noted errors is applicable to these claims with respect to the Alverson/Angelo combination.

The Examiner's additional admission that "Angelo fails to particularly disclose that the information includes instruction traces" is very much appreciated (page 11). However, the Examiner's assertion that "saving instruction traces is common in the art and can be utilized for many debugging purposes" is respectfully traversed.

As noted in the Manual of Patent Examining Procedure (MPEP) Section 2144.03, "if the applicant traverses such an assertion [of official notice of facts outside of the record] the examiner should cite a reference in support of his or her position." While this new rejection was only recently instituted in the Final Rejection (even though claims 9, 10, 17 and 37 are in their original form), the burden is on the Examiner to establish some prior art disclosure if his contention is traversed. Applicants respectfully traverse the Examiner's contention and had no previous opportunity to respond to the contention, since it was not raised until the Final Rejection.

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Accordingly, the Examiner's rejection of claims 9, 10, 17 and 37 is traversed as being unsupported by the admitted defects in the Alverson and Angelo references and the failure to cite any "common art" supportive of the Examiner's position.

SUMMARY

Neither Angelo or Alverson disclose Applicants' claimed setting of at least one control value. There is no demonstration of how or where the Alverson or Angelo references teach the claimed "not allowing initiation" feature. The Angelo reference specifically teaches away from the claimed feature because it suggests that entry into SMM is always in response to an SMI which the Examiner believes is analogous to Applicants' "control value." Finally, the failure to disclose what the Examiner believes to be "common art" is fatal to the rejection of the cited rejected dependent claims.

As a result of the above, there is simply no support for the rejection of Applicants' independent claims 1 and 20 or claims dependent thereon under 35 USC §103. Applicants respectfully request that the Pre-Appeal Panel find that the application is allowed on the existing claims and prosecution on the merits should be closed.